

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-8 and 21-26 are now present in this application. Claims 1, 5 and 23 are independent.

Claims 1, 5 and 23 are amended. Reconsideration of this application, as amended, is respectfully requested.

Premature Final Rejection

This rejection contains a new ground of objection to the claims, which is tantamount to a rejection under 35 USC §112, second paragraph, and which requires the amendment of claim 5. Applicant did not amend claim 5 so as to require this new ground of objection, which is tantamount to a new ground of rejection, yet this objection requires amendment of at least claim 5 to overcome the objection.

Accordingly, this Office Action was improperly made final and the finality of this Office Action should be withdrawn.

Moreover, because the rejection was improperly made final, this Amendment should be entered as a matter of right.

Entry of Amendments

Applicant respectfully submits that it is proper to enter the amendments to claim 5 to reduce or eliminate those issues on appeal, and to enter the amendments to claim 1 because they place the application in condition for allowance. Moreover, as pointed out above, it is proper to enter all amendments because the outstanding Office Action should not have been made final.

Priority Under 35 U.S.C. §119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. §119, and receipt of the certified priority document.

Rejection Under 35 U.S.C. §102

Claims 1, 3 and 4 stand rejected under 35 U.S.C. §102(a) as being anticipated by the Applicant's Conventional Art. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

As pointed out in the previous Amendment, filed March 23, 2004, no admission has been made by Applicant that Figures 4A and 4B qualify as

statutory prior art usable in a rejection of the claims of the present application. Instead, Applicant has labeled Figures 4A and 4B as "Conventional Art" to distinguish Applicant's invention from that which is not Applicant's invention. The Applicant respectfully requests that the Examiner withdraw this art grounds of rejection, or provide evidence that these figures qualify as statutory prior art.

In response to this argument, the Office Action relies on In re Nomiya, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). Applicant respectfully submits that the Nomiya case is inapposite. In Nomiya, the applicants filed a patent application containing two figures labeled as "prior art" and described as such in the specification. *Id.* at 570-71, 184 USPQ at 611. The Examiner rejected the pending claims as obvious over a U.S. patent in light of the two figures. *Id.* The applicants argued that the figures could not constitute prior art absent a statutory basis in section 102. This court's predecessor disagreed: "By filing an application containing Figs. 1 and 2, labeled prior art, *ipsissimis verbis*, and statements explanatory thereof appellants have conceded what is to be considered as prior art in determining obviousness of their improvement." *Id.* at 571, 184 USPQ at 611-12 (footnote omitted).

In this case, Applicant does not have any figures that are labeled as "prior art."

Furthermore, a rejection must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). The Office Action has provided no objective evidence of a clear, unmistakable and equivocal admission that claims 1-4 are prior art to Applicant. All that is presented in this regard is speculation.

Applicant has not admitted that Figures 1-4 are prior art to Applicant. In Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v. Barron et al., 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicant has done is to refer to Figs. 1-4 as "Conventional Art." Something can be conventional art in the sense that it is practiced in the real world at the time of Applicant's filing of this Application and may yet not be prior art to Applicant in any sense, including, for example, under 35 USC §103, which forms the basis for this rejection. See, in this regard, the relatively recent amendments to 35 USC 103(c).

Under the circumstances, i.e., where Applicant merely describes Figs. 1-4 as conventional art, the Office Action has not established that Applicant has made a clear, unequivocal and unmistakable admission on the record that what is disclosed in Figs. 1-4 is prior art to Applicant. In this regard, the Examiner is also advised that the initial burden to establish something as prior art is on the Office as part of its burden of making out a *prima facie* case of unpatentability.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicant respectfully submits that the Office has not made out a *prima facie* case of unpatentability at least because it has not made out a *prima facie* case that Figs. 1-4 are prior art to Applicant.

The statement on page 11 that "the burden is on the applicant to provide evidence that the figures labeled and discussed as 'conventional' are not indeed conventional in the art. At this point no evidence has been provided in support of the position that the figures are not admitted prior art," is incorrect and is an improper attempt by the Office to shift its burden of proof of making a *prima*

facie case that Applicant has made a clear, unmistakable and unequivocal admission that Figs. 1-4 are prior art to Applicant.

Moreover, Applicant respectfully submits that independent claim 1 has been amended to recite a combination of features in a liquid crystal display device, including a second metal layer comprising a mask having a same pattern and for defining and forming a separation between the source electrode and drain electrode, and wherein the first metal layer is patterned using the second metal layer as a mask so that etched side-walls of the first metal layer and the second metal layer are substantially aligned, and that these features are not disclosed by the applied art, which, as noted above, the Office has not established by objective evidence to even be prior art.

Claims 3 and 4 depend on claim 1, and therefore are patentable, at least for the reasons stated with respect to independent claim 1.

Accordingly, reconsideration and withdrawal of this ground of rejection is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Applicant's conventional art figure 2, in view of U.S. Patent No. 6,078,365 to Ueda et al. (Ueda). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Moreover, as noted above, the Office Action fails to provide any objective evidence of proper motivation to modify Fig. 2, which has not been established to be prior art to Applicant and, thus, this rejection is fundamentally improper.

Furthermore, in rejecting claims under 35 USC 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden

of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

One reason alleged in the Office Action that one of ordinary skill in the art would have to desire to modify Fig. 2 of the non-prior art on which this rejection is based, in view of Ueda is "because they are from the same field of endeavor." Applicants respectfully submit that this reason is not "clear and

particular”, but is merely a broad conclusory statement about the teaching of Ueda, and, standing alone, is not “evidence” of proper motivation to modify Fig. 2 in view of Ueda. See In re Dembiczak, cited above.

The Office Action also states that one of ordinary skill in the art would be motivated to include aluminum in the electrodes to lower their resistance for improved conductivity of the circuit components.

In making a rejection under 35 USC §103, the prior art as a whole must be considered. The teachings of the applied references are to be viewed as they would have been viewed by one of ordinary skill in the art. Kimberly-Clark v. Johnson & Johnson, 745 F.2d 1437, 1454, 223 USPQ 603, 614 (Fed. Cir. 1984); In re Mercier, 515 F.2d 1161, 1165, 185 USPQ 774, 778 (CCPA 1975). “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art”. In re Wesslau, 353 F.2d at 241, 147, USPQ at 393. In re Hedges, et al., 228 USPQ 685 (Fed. Cir. 1986).

In this instance, the Office Action has not established any prior art for Ueda to modify.

Moreover, Fig. 2, which has not been established as prior art to Applicants under 35 USC 103(c), does not indicate any problems such as a

need for improved conductivity of its circuit components. Only Applicant's disclosure discloses a problem that needs to be solved and a solution for that problem.

This rejection is treating Applicant's disclosure as prior art with no proper basis on which to do so. In making its determination the prior art must be viewed without reading into that art the patent's teachings. In re Spinnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). Moreover, "discovery of the source of a problem" is part of the "subject matter as a whole" to be considered in determining obviousness – see Spinnoble, cited above.

In this regard, the Office Action provides no objective evidence of prior art disclosing the problem that Applicant overcomes. Furthermore, in Ueda, ohmic contact layer 79 is disclosed to be transparent, whereas aluminum is not transparent, so the alleged motivation to use aluminum is contradicted/taught away from by Ueda's own disclosure.

This rejection is a prime example of improper hindsight reconstruction of Applicant's invention based on Applicant's own disclosure of his invention, and that is fundamentally improper.

Further, with regard to independent claim 5, Ueda consistently discloses adjacent films being patterned in almost the same shape. With particular regard to layer 79, Ueda teaches the "metal film 79, the n+ type a-Si film 78, an a-Si film 77, and an SiN_x film 76 as a gate insulating film are continuously

etched and patterned into almost the same shape. The Applicant respectfully submits that “same” and “almost the same” are not the same with respect to a semiconductor layer having the same pattern as the first metal layer.

Therefore Ueda fails to teach or suggest a combination of elements in a liquid crystal display device, including a source electrode and a drain electrode over the first semiconductor layer, the source electrode and drain electrode including a first layer and a second layer patterned to form a separation region between the source and drain electrodes; and a second semiconductor layer beneath the first metal layer and having a same pattern as the first metal layer, as recited in independent claim 5. Applicants continue to present this argument as valid despite the comments in the Office Action that Ueda is not relied on for this feature, because the Office Action fails to establish this feature in any prior art whatsoever.

With regard to dependent claims 2-4 and 6-8, Applicant submits that claims 2-4 and 6-8 depend, either directly or indirectly, from independent claims 1 and 5, which are allowable for the reasons set forth above, and therefore claims 2-4 and 6-8 are allowable based on their dependence from claims 1 and 5. Reconsideration and allowance thereof are respectfully requested.

With respect to claims 21-26, although the caption of the rejection found on page 5 of the Office Action does not mention that claims 21-26 are rejected, these claims are treated in the body of the rejection and in the Summary of the

Office Action as being rejected and will be addressed below as being rejected on their merits, as follows.

As pointed out above with respect to claims 1-8, the Office Action has not established any prior art for Ueda to modify and the rejection is improper for at least this reason.

Additionally, the Office Action has not provided proper motivation to combine the improper, non-established-to-be, prior art with Ueda. One alleged reason that one of ordinary skill in the art would have to desire to modify Fig. 2 of the non-prior art on which this rejection is based, in view of Ueda is "because they are from the same field of endeavor." Applicants respectfully submit that this reason is not "clear and particular", but is merely a broad conclusory statement about the teaching of Deardorff, and, standing alone, is not "evidence" of proper motivation to modify Figs. 1-3 in view of Deardorff. See In re Dembiczak, cited above.

The Office Action also states that one of ordinary skill in the art would be motivated to include aluminum in the electrodes to lower their resistance for improved conductivity of the circuit components. This is not considered persuasive for a number of reasons, including the fact that the Office Action provides no objective evidence of prior art disclosing the problem that Applicant overcomes, and because in Ueda, ohmic contact layer 79 is disclosed to be

transparent, whereas aluminum is not transparent, so the alleged motivation to use aluminum is contradicted/taught away from by Ueda's own disclosure.

Similar comments apply to dependent claims 24-26.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

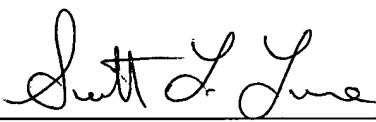
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Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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